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Response To First Office Action

From: Joseph E. Funk, Attorney for Applicant

Phone No.: (603) 432 - 8788

Fax No.: (603) 421 - 2779

=====

To Examiner: Thomas R. Peeso

Phone No.: (571) 272 - 3809

Group Art Unit: 2132

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Applicant: Bruce C. Monk

Serial No.: 10 / 022,634

Filed: December 17, 2001

Title: Document and Bearer Verification System

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Bruce C. Monk
Serial No.: 10/022,634
Filed: Dec. 17, 2001
Title: Document and Bearer
Verification System

Date: September 24, 2005
Group Art Unit: 2132
Examiner: Thomas R. Peeso

HON. COMMISSIONER OF PATENTS AND TRADEMARKS
WASHINGTON, D.C. 20231

RESPONSE TO FIRST OFFICE ACTION

This paper is in response to an Office Action dated June 24, 2005.

Please amend the specification as shown in the attached "SPECIFICATION AMENDMENTS". Please amend the claims as shown in the attached "CLAIM AMENDMENTS".

COMMENTS

The Examiner first rejects claims 1 - 5, 9, 11 - 16, 18, 20, 21, 23 - 26 under 35 USC 102(b) as being clearly anticipated by U.S. Patent No. 6,070,240 to Xydis. Continuing, the Examiner stats that: "As per claims 1-3, 8, 9, 13-16, 20, 23-26, Xydis discloses identifying a databaseobtained information), comparing the information to anyone and providing an indication the identified database (col. 3, lines 26-45)."

The applicant respectfully disagrees with the Examiner for the following reasons. First the invention of the Xydis patent is entirely different than the applicant's invention and they are used for purposes that are widely different. The invention of the Xydis patent is for controlling a computer system being used only by a person having a transponder 22 on their person, the presence of which is detected using a transceiver 20 in near proximity to the

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computer 12, and if an authorization code in the transponder 22 matches a code in a database 26 of codes the bearer of the transponder 22 is permitted to use computer 12.

In distinct contrast, with the applicant's invention provides security at a couple of different levels against wrongfully obtaining and using documents, by checking any information, documents or biometrics submitted by person to obtain or use a document against a plurality of state, federal and international databases to check the validity of the person and the documents they are submitting, while at the same time checking if the person is authorized to do something, is wanted by the authorities, or is on a watch list.

The preamble of applicant's claim 1 talks of "databases" (plural) and these multiple databases are seen in applicant's Figure 2 and range the gamut of state, federal and international databases. All other independent claims are the same in this regard. The applicant's invention is meaningless without being able to access these many databases. The applicants have amended all independent claims 1, 8, 15, 20, 23, 24, 25 and 26 to make this point very clear.

In the Xydis patent there us only one database taught and needed - the "database of authorized users 26". There are no other databases taught suggested in the Xydis patent, and there is no possible need for any database except database 26.

The preamble of applicant's claim 1 also mentions "biometric and / or other information obtained from persons and / or documents to verify the identity of the person and / or the validity of the documents".

In the Xydis patent there is no requirement for any such thing. An "authorized user" has already been issued a "transponder 22" to gain access to and use "main computer 12". The presence of the transponder 22 near the computer 12 is detected and indicates that the bearer of the transponder is authorized to use the computer. There is no mention or

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suggestion of the need for biometrics, documents or other information from a person carrying a transponder to "verify the identity" of that persons.

In the main body of applicant's amended claim 1 the first step is "identifying ones of the multiple databases that contain information necessary for verifying the obtained information". In the Xydis patent there is no need to identify any database since there is only one database and that database is used to determine if the authorization code in a transponder is authorized access to computer 12. In the present invention there are a multiple of databases as seen in applicant's Figure 2.

Further, applicant's claim 1 claims that the information is obtained from "persons and/or documents". The only place that information is obtained from in the Xydis patent is from transponder 22 and that is the authorization code. It is a far stretch of the imagination to state that the transponder is either a person or a document. There is no language in the Xydis patent, the applications application, a dictionary or any other source material that supports that a transponder may be considered a document.

Independent claims 8, 15, 20, and 23 - 26 all contain similar restrictions that are not found or suggested in the Xydis patent or in its claims. In addition, for example, applicant's claim 15 includes: "returning the match indications to the terminal from which the obtained information that was compared to database information was originally sent." In the Xydis patent this would mean that the results of the comparison made in comparator 29 are returned to transceiver 20 or the transponder 22 which is not done, nor is there any reason to do so.

In the Xydis patent we read at col. 3, l. 1 et seq. that transponder 22 "sends a response radio frequency signal carrying the authorization code, and receiving the response radio frequency at the transceiver 20." At col. 3, l. 35 et seq. we read of a "comparator 29 for comparing the first authorized user code to the database 26 for verification". ... "When

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that first authorized user code matches a code stored in the database 26, the communications controller 24 unlocks the computer 12 for use by the first authorized user”.

Comparing this operation of the Xydis patent against the applicant's invention. Applicant's claim 20 reads: “at least one trust authority server associated with at least one of the databases, and the obtained information is forwarded via the information verification server to the trust authority server associated with the identified database(s), and the trust authority server compares the obtained information forwarded to it to verify the obtained information without disclosing database information to anyone; and”.

Since the applicant's “trust authority server compares the obtained information forwarded to it to verify the obtained information” it must be the comparator 29 in the Xydis patent. Applicant's claim 15 also reads that the “obtained information is forwarded via the information verification server to the trust authority server. In the Xydis patent the information (authorization code) is obtained by transceiver 20 and it is compared by comparator 29. There is nothing in Xydis that can be equated to the applicant's “information verification server” that forwards the authorization code to the comparator. The applicant needs the information verification server since there are many databases and many servers in contrast to the Xydis patent which has only one database.

Thus, the Xydis patent does not teach elements that can be equated to all the elements in applicant's claim 15.

Next, the Examiner states that: “As per claims 4, 5, 11, 12, 18, 21, Xydis discloses the limitations of these claims (col. 3, 56 - 61).” Claims 4, 5 and 12 are dependent from independent claim 1 which is believed to be distinguished from the Xydis patent as detailed above. Claim 11 depends from independent claim 8 which is also believed to be distinguished from the Xydis patent for the same reasons that claim 1 is distinguished as detailed above. Claim 18 depends from independent claim 15 which is also believed to be

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distinguished from the Xydis patent for the same reasons that claim 1 is distinguished as detailed above. Finally, claim 21 depends from independent claim 20 which is also believed to be distinguished from the Xydis patent for the same reasons that claim 1 is distinguished as detailed above.

The Examiner then rejects claims 6, 7, 10, 17, 19, 22 "under 35 U. S. C. 103 (a) as being unpatentable over Xydis as applied to claims 1-5, 8, 9, 11-16, 18, 20, 21, 23-26 above, and further in view of the Examiner taking official notice."

Continuing, the Examiner admits that the Xydis patent "does not specifically disclose these features" in claims 6, 7 and 22 and argues that the features are "known in the art. It would have been obvious to anyone having an ordinary level of skill in the art at the time the invention was made to have modified the invention of Xydis to include these features since the information being provided most likely will always be contained in the document and the person providing the information is certainly a trusted source." This is an attempt at hind sight. In addition, these claims depend from independent claims that are believed to be distinguished from Xydis as previously detailed, so are also believed to be allowable in that manner.

These claims depend independent claim which are believed to be distinguished from the Xydis patent for the same reasons that claim 1 is distinguished as detailed above.

In addition, for the applicant's invention to be obvious in view of the patent combination cited by the Examiner the need for the novel combination and operation must be at least suggested in the cited prior art or we have hindsight.

In the key case *In re Fine*, 837 F.2d 1074, 5 USPQ2d 1596, (Fed. Cir. 1988), the court stated:

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"But whether a particular combination might be 'obvious to try' is not a legitimate test of patentability. Obviousness is tested by 'what the combined teachings of the references would have suggested to those of ordinary skill in the art', but it 'cannot be established by combining the teaching of the prior art to solve the problem of the claimed invention, absent some teaching or suggestion supporting the combination.' Here the prior art contains none. And '*teaching of references can be combined only if there is some suggestion or incentive to do so.*' Here the prior art contains none."

"Instead, the Examiner relies on hind sight in teaching his obviousness rejection. "But, this court has said, to 'imbue one of ordinary skill in the art with the knowledge of the individual, in suite, when no prior art reference or references as of record convey or suggest that knowledge is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teaching'. It is essential that 'the decision maker forget what he or she has been taught about the claimed invention and casts the mind back to the time the invention was made ... to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then accepted wisdom in the art."

"id. One cannot use hindsight reconstruction to pick and choose among isolated disclosures of the prior art to deprecate the claimed invention."

Again in *Para-Ordnance Mfg., Inc. v. SGS Importers Int'l, Inc.*, 37 USPQ2d 1237 (Fed.Cir. 1995) the court stated:

"For a combination of prior art references to render an invention obvious, "there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make

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the combination." In re Oetiker, 977 F.2d 1443, 1447, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992). That one must point to some reason, suggestion, or motivation to make a combination is not to say that the teaching must be explicit, but in order to render an invention obvious by the combination of prior art references, the record must contain some basis to rebut the presumption of validity. See, e.g., Vandenberg v. Dairy Equip. Co., 740 F.2d 1560, 1568, 224 USPQ 195, 198 (Fed. Cir. 1984). A finding of obviousness on any other basis would constitute hindsight. See Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) ("When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.").

"A simple invention may be patentable, even if the invention comprises the combination of features known in the art, provided the combination itself is not obvious. See In re Sponnoble, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969) ("A patentable invention, within the ambit of 35 U.S.C. § 103, may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use.")

As for applicant's claims 10, 17 and 19 the "examiner further takes official notice that this limitation is when in the art since the remote location isolates the comparison means from the identifying means in order to ensure that no conflict results which could compromise the security of the information." These claims depend from independent claims that are believed to be distinguishable from Xydis for the reasons previously presented for claim 1.

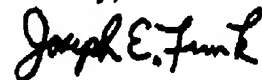
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The Examiner finally cites U.S. Patents 5131038 to Puhl et al., 5343529 to Goldfine et al., and 4980913 to Skret as "prior art made of record and not relied upon" but "considered pertinent to applicant's disclosure." The applicants have reviewed these patents and do not believe that they suggest or teach the applicant's invention either individually or in combination with others of the cited patents.

The applicant has discovered some minor mistakes in the specification that are being corrected herein. See the Amendments to Specification.

In view of the above arguments and amendments, this patent application is believed to be in condition for allowance and passage to issuance is respectfully requested. If there remain any matters that may be resolved by telephone the Examiner is invited and authorized to contact the undersigned attorney via telephone at (603) 432-8788, via fax at (603) 421-2779, or via e-mail at jfunk777@adelphia.net.

Sincerely,



Joseph E. Funk, Esq.
Reg. No. 25,974
Attorney for Applicant